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| APPLICATION NO.                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/600,209                           | 06/20/2003  | Dhananjay V. Keskar  | 042390.P16126       | 9022             |
| 45209                                | 7590        | 10/23/2008           |                     |                  |
| INTEL/BSTZ                           |             |                      | EXAMINER            |                  |
| BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP |             |                      | SMITH, CREIGHTON H  |                  |
| 1279 OAKMEAD PARKWAY                 |             |                      |                     |                  |
| SUNNYVALE, CA 94085-4040             |             |                      |                     |                  |
|                                      |             |                      | ART UNIT            | PAPER NUMBER     |
|                                      |             |                      | 2614                |                  |
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|                                      |             |                      | 10/23/2008 PAPER    |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/600,209

**Applicant(s)**

KESKAR ET AL.

**Examiner**

Creighton H. Smith

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE filed on 25 AUG '08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Applicant's arguments filed with RCE on 25 AUG '08 have been fully considered but they are not persuasive. Applicant argues on page 8 of the remarks the examiner "glosses over" the crux of their invention, i.e., the user-specific info and the environmental info. Examiner disagrees. Initially, there is no claimed language directed towards "environmental information", so examiner will assume that applicant means the "user's physical context information". Since, as argued infra, Bork discloses applicant's physical context information in col. 2 and in col. 8 discloses that his GPS will disclose the user location information, and O'Neill teaches the schedule information it is deemed that the specifics of each reference are readily combinable with one another.

On page 9 of the remarks applicant argues the wrong test. It is no longer the TSM test as elicited by the CAFC, but common sense test as elicited by the USSC.

Applicant's arguments filed 16 JAN '08 have been fully considered but they are not persuasive. Applicant's device is a method of enabling a mobile device to notify a user. Likewise, Bork et al mobile device (100) is an "intelligent alerting system", col. 2, line 4. Alerting (Bork) = notification (applicant). Therefore, examiner disagrees with applicant's assertion that Bork describes a system "merely sensitive to its environment.

Applicant discloses in [0010] that the physical context information is: ambient light, tactile information, ambient noise, accelerometer, and orientation. Likewise, Bork discloses in col. 2, lines 4-6 & 57-56, noise, light, temperature, motion sensing, AND the date. Additionally, Bork et al disclose in col. 8, lines 30-40, that GPS can be

used to determine the location of the mobile. The schedule info is disclosed in the secondary reference to O'Neill et al.

Regarding applicant's arguments towards the combinability of Bork et al and O'Neill et al, the test is no longer one of a teaching, suggestion, or modification ("TSM"), but rather one of common sense. The United States Supreme Court ("Court") held in KSR INTERNATIONAL Co. v. TELEFLEX INC. et al. that the Federal Circuit's TSM test was in a too rigid and narrow manner. See page 3 of Syllabus. The Court stated that to "grant patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, *for patents combining previously known elements* (emphasis added), deprive prior inventions of their value or utility," Syllabus – page 5. the previously known elements in out application are the location and physical information provided by Bork et al and O'Neill et al providing the scheduling info. So, all elements claims by applicant have previously been invented by Bork et al and O'Neill et al. Now the only question is, as to the Court's holding, is whether the references are combinable under the common sense test. The Court cited Sakraida v. AG Pro, Inc., 425 U.S. 273 which held that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious. Similarly, applicant is doing what was the holding in Sakraida , arranging old and well known elements yielding no new results. Therefore, using the common sense approach of combining old and well known elements that yields no new results would have been obvious.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 10, 12-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bork et al in view of O'Neil et al, U.S. Patent Publication #2004/0224693.

Bork's wireless communication device has an intelligent alerting system, col. 3, lines 34-36. The wireless device has an alerting system that is determined from the operating environment. The terminal's CPU will adjust the audio, visual, and tactile alerting signals based on the operating environment. Bork et al disclose a few examples of a user's "physical context information" in col. 2, lines 4-6 & 57-65, where Bork discloses that the wireless device samples the noise level surrounding the terminal and other inputs such as light sensing, temperature sensing, motion sensing and the date. Bork's light, temperature, and motion sensing inputs reads upon applicant's "physical context information" and Bork's real time clock including date reads upon applicant's "location information". Also see col. 6, lines 53-60; col. 7, lines 53-61. Bork et al also disclose a real time clock **202** (including date) – col. 9, lines 42 et seq. The date, i.e., the time of day, is used to establish an alert based upon the time of day. The "date" and "time of day" disclosed by Bork et al reads upon applicant's location information.

Bork et al fail to disclose that schedule information is one of the inputs that is going into their alerting system. However, O'Neil et al do disclose in ¶-0076 that the Personal

Information Manager keeps a calendar for the customer notifying him/her of appointments, meetings, deadlines, etc. To have incorporated O'Neil et al teaching of using a calendar/scheduling information as part of the alerting/notifying means in Bork et al wireless device would have been obvious to a person having ordinary skill in the art because both Bork et al and O'Neil et al are disclosing different input means that are used to generate alerts in wireless, mobile devices, and the skilled practitioner in the wireless arts with these two references in front of her would have found them readily combinable because of the fact that different inputs are being used to generate the alerts in Bork et al than in O'Neil but common sense would show that the alerts of either reference could easily be used in the other reference.

For claim 2, Bork et al disclose in col. 2, line 7, that the wireless device will modify its notification behavior by generating either a tactile (vibrating), or visual signal. This meets applicant's limitations of claim 2 of a flashing display screen and a blinking LED.

Concerning claim 4, Bork et al disclose in col. 2, lines 35 et seq. that one of the physical pieces of information is passive audible sensing of the environment which meets applicant's limitation in claim 4 of "ambient noise information." In lines 56 et seq. of col. 2, Bork discloses some other physical pieces of information that affect the alerting signal in the wireless device are: light sensing, temperature sensing, and motion sensing.

For claim 18, see Bork et al cols. 10-11, lines 65-67 & 1-4.

Any inquiry concerning this communication should be directed to Creighton H. Smith at telephone number 571/272-7546.

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20 OCT '08

/Creighton H Smith/  
Primary Examiner, Art Unit 2614